

Remarks

The claims were amended in accordance with the amendments above. The amendments to the claims are being made merely to clarify the invention. All of the amendments are fully supported by the specification, claims, and figures as originally filed. No new matter is believed or intended to be involved.

Elections/Restrictions

In the Office Action dated 02/11/2008, the Office appears to have inadvertently mischaracterized Applicant's election made in the reply that was filed 11/19/2007. In particular, the Office stated that Applicant only elected claims 1-9, 11-12, and 38-47 in the reply that was filed 11/19/2007. However, closer inspection of the reply that was filed 11/19/2007 reveals that Applicant in fact elected a species (core jacketed with a permeability selective membrane) that was covered by claims 1-9, 11-24, 27-28, and 31-47. In other words, the Office has overlooked the fact that claims 13-24, 27-28, and 31-37 were also covered by Applicant's election, not just claims 1-9, 11-12, and 38-47. Claims 27-28 and 31-37 should therefore not have been deemed withdrawn.

In view of the foregoing, all of claims 1-9, 11-24, 27-28, and 31-47 were under active prosecution as of the date the present Office Action was mailed. (See p. 2, line 2 of reply filed 11/19/2007). The only claims that would be properly deemed withdrawn are claims 10, 25-26, and 29-30. Applicant therefore respectfully requests that the Office explicitly acknowledge the full scope of Applicant's election.

§102 Rejections

Claims 1-9, 11-16, 19, and 24 were rejected under 35 U.S.C. §102(b) as being unpatentable over Matsuura et al. (US Patent No. 6,171,298). Claims 17-18, 20-23 and 38-47 were objected to as dependent upon a rejected base claim. Under MPEP 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim. In addition, the elements in the prior art reference must be arranged as required by the claim. MPEP 2131 (emphasis added).

Applicant submits that Matsuura fails to teach or suggest all of the limitations recited in amended independent claim 1, particularly in the arrangement required by the claim. For instance, amended independent claim 1 recites “an external selectively permeable jacket surrounding the core, the jacket comprising a biocompatible membrane having a molecular weight cutoff permitting passage of active agent molecules to and from the core through the jacket to provide the biological product or function.” Matsuura fails to teach or suggest such limitations, among others, particularly in the arrangement required by claim 1. Accordingly, Matsuura fails to anticipate claim 1 in accordance with MPEP 2131. Applicant therefore respectfully requests that the rejection be withdrawn.

Applicant further traverses the Office’s contention that “material would be inherently radio-opaque” if it is “more dense than surrounding tissues.” This finding does not meet the standard required by MPEP 2112. In particular, the Office has failed to provide extrinsic evidence that something that is more dense than surrounding tissues must necessarily be radiopaque. In other words, the Office has not provided an evidentiary basis to rule out the possibility that a material may be more dense than surrounding tissues yet not be radio-opaque.

Applicant further notes that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for novelty.

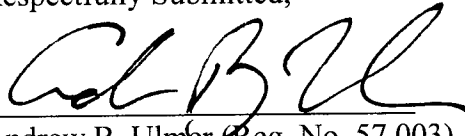
Conclusion

While several distinctions have been noted over the art of record, Applicant notes that there are several other limitations recited in the present claims which are neither taught nor suggested by the art of record. Applicant expressly reserves all rights and arguments with respect to distinctions not explicitly noted herein. In addition, to the extent that the amendments constitute a narrowing of the claims, such narrowing of the claims should not be construed as an admission as to the merits of the prior rejections. Indeed, Applicant traverses the rejections and preserves all rights and arguments. To the extent that any particular statement or argument by the Office in the pending Office Action has not been explicitly addressed herein, the same should not be construed as an acquiescence or admission by the Applicant that such statements or arguments by the Office are accurate or proper.

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance. Should the Examiner wish to discuss the amendments or arguments made herein, Applicant invites the Examiner to contact the undersigned at (513) 369-4811 or via e-mail at aulmer@fbtlaw.com.

The Commissioner for Patents is hereby authorized to charge any deficiency or credit any overpayment of fees to Frost Brown Todd LLC Deposit Account No. 06-2226.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'A. B. Ulmer', written over a horizontal line.

Andrew B. Ulmer (Reg. No. 57,003)
FROST BROWN TODD LLC
2200 PNC Center
201 East Fifth Street
Cincinnati, Ohio 45202
(513) 369-4811
aulmer@fbtlaw.com

CinLibrary 1785925